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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,164	09/30/2003	Edward J. Madachik JR.	16-520	6703

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EXAMINER
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TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/676,164

Applicant(s)

MADACHIK, EDWARD J.

Examiner

Philip C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 36-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-18, 22-35, 68 and 69 is/are rejected.
- 7) ☒ Claim(s) 4-6 and 19-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-35, 68, 69, drawn to a chemical composition, classified in class 507, subclass 261.
  - II. Claims 36-67, drawn to a method of removing contaminants from a well, classified in class 166, subclass 311.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the composition may be used in cleaning other than a wellbore.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with George Pinchak on 12/5/05 a provisional election was made with traverse to prosecute the invention of I, claims 1-35, 68, 69. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 36-67 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### CLAIMS INTERPRETATION

5. Claims 8-10, 23-25 and 34-35 are only examined with respect to the composition. The combination with a treating fluid is an intended use, which is not part of the claimed composition.

### ***Claim Objections***

6. Claims 32-35 are objected to because of the following informalities: There is no antecedent basis for "The composition" in the claims or parent claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 7-16, 22-31 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Burlew (6100227).

Burlew teaches a cleaning composition a polyoxyethylene ethers and alkoxylate within the scope of the first and second surfactants, and a sulfonate surfactant within the scope of the third surfactant (see column 2, line 42- column 3, line 5 and claim 1). The aliphatic alcohol is both a solvent and coupling agent. The methyl pyrrolidinone also acts as a solvent. The present invention is thus anticipated by Burlew.

9. Claims 1, 7-16, 22-31 and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by WO/0123703.

WO '703 teaches a cleaning composition for wells, which comprises an alkyl glucoside, and an ethoxylated alcohol within the scope of the first and second surfactant, and a quaternary ammonium surfactant which can have an HLB up to 22 (page 6, line 8 and the claims). Water, alcohols and glycols which are also coupling agents may be used in the composition (see page 6). In view of the teaching of the first paragraph of page 8, such solvent would be within the scope of the present invention.

10. Claims 1, 7-12, 14-16, 22-27, 29-31, 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan (5996692).

Chan teaches a cleaning composition which comprises an alkyl glucoside and ethoxylated alcohol within the scope of the first and second surfactant, and a sodium

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salt of an iminopropionic acid which is within the scope of the third surfactant (column 6, lines 8-13, and the claims). The alkyl alcohol is a coupling agent and solvent. The composition also contains water. The present invention is thus anticipated by Chan.

11. Claims 31 and 32 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Diacid H240 was on sale, and is a combination of the diacid in claim 32 and a solvent. In claim 31, "about zero" is used for components a) b) and c), and as such zero amounts of these components may be present.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3, 7-18, 22-31, 33-35, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Slyke (5780407).

Van Slyke teaches a cleaning composition which comprises a combination of surfactants which have a combined HLB value of at least 11, and a least one diluent oil, and possibly water (see claim 1). Surfactants within the scope of the three surfactants of the present invention may be combined to form a surfactant with the HLB of at least 11. See column 7, line 28 – column 8, line 62). Van Slyke differs in that a specific

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combination within the scope of the present invention is not exemplified. However, it would be obvious to one of ordinary skill in the art to use a mixture of the surfactants having values within the scope of the present invention, particularly in view of the teaching of the claims, for using surfactants from each category. The plant oils, carboxylic acids and alcohols, may act as coupling agents and solvents within the scope of the present invention.

14. Claims 4-6 and 19-21 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip C Tucker  
Primary Examiner  
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PCT-3910